

AMENDMENTS TO THE DRAWINGS

Ten (10) replacement sheets of drawings are submitted herewith, containing FIGS. 3-11. The replacement sheets are being submitted as formal drawings, without any hand-written numberings. The Applicant submits that no new matter has been introduced by the replacement sheets.

REMARKS / ARGUMENTS

The present application includes pending claims 1-22, all of which have been rejected. By this Amendment, claims 1-6, 8, 10, and 12-21 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 1, 4-8, 10 and 12-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,659,366, issued to Kerman (hereinafter, Kerman). Claims 2, 3, 9, 11 and 19-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kerman, in view of U.S. Patent No. 7,233,781, issued to Hunter, et al. (hereinafter, Hunter). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 102

I. Kerman Does Not Anticipate Claims 1, 4-8, 10 and 12-18

The Applicant first turns to the rejection of claims 1, 4-8, 10 and 12-18 under 35 U.S.C. 102(b) as being anticipated by Kerman. With regard to the anticipation rejections under 102(b), MPEP 2131 states that "[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See *id.* (internal citation omitted).

A. Independent Claims 1, 12 and 15

With regard to the rejection of independent claim 1 under 102(b), the Applicant submits that Kerman does not disclose or suggest at least the limitation of "detect at least a portion of the media content that is newly accessible to the at least one communication device and to provide at least one indication relating to the detection of the newly accessible media content ... **prior to accessing of the newly accessible media content by the at least one communication device,**" as recited by the Applicant in independent claim 1 (emphasis added).

The Office Action states the following:

Regarding **claim 1**, the claimed "a display communicatively coupled to at least one communication device, the communication device being in at least one of a "standby" mode or an "off" mode" is met by Kerman teaching a video display 136 and a communication device (tuner 105, host microcontroller 110, data decoder 125, light source 200, & audio source 205 - Fig.2) being in "standby" mode (Fig.1 & 2; col.3, lines 3-12; and col.5, lines 16-21). The claimed "communication network communicatively coupled to the at least one communication device" is met by Kerman teaching a device that receives incoming television signals being transmitted over a wireless or cable infrastructure network through the use of an antenna or cable (Fig.1 & 2; col.2, lines 14- 15; and col.4, lines 64-66). *The claimed "media content disposed in at least one of the communication network and the at least one communication device, the at least communication device adapted to detect the media content that is newly accessible to the at least one communication device and to provide indications relating to the detection of the newly available media content, the indications being provided on at least one of the display and the at least one communication device" is met by Kerman teaching a device that serves to notify a television viewer of the occurrence of a certain event through the use of an alert signal, such as a visible or audible*

alert and that the alert message can be displayed on a video display (Fig.1 & 2; col.3, lines 3-34; and col.4, lines 55-63.

See Office Action at pages 2-3 (emphasis added). The Applicant points out that **Kerman discloses a notification system for television receivers, which operates by extracting and processing an information signal from the received television signal.** See Kerman at col. 4, lines 33-36. In other words, **Kerman generates a notification only after the media content is accessed or received.** This is further supported by Kerman's embodiments illustrated in Figures 4-7 of Kerman. For example, Figure 4 of Kerman illustrates a notification system where the detected event is a message received as a part of the information signal (i.e., the signal is already received). See *id.* at col. 5, lines 62-67. Figure 5 of Kerman illustrates a notification system where the user is being notified that a previously selected program is being transmitted and is available for viewing (i.e., the desired signal/program is currently being transmitted). See *id.* at col. 5, lines 62-67. Figure 6 of Kerman illustrates a notification system where an audible alarm is used to indicate when a program on a list of undesired programs is being received (i.e., the program is currently being received). See *id.* at col. 8, lines 8-13. Figure 7 of Kerman illustrates a notification system where an audible alarm is used to indicate when a program having an undesired rating is being received (i.e., the undesired program is currently being received). See *id.* at col. 8, lines 57-62.

Therefore, the Applicant submits that Kerman does not disclose or suggest at least the limitation of "detect at least a portion of the media content that is newly accessible to the at least one communication device and to provide at least one indication relating to the detection of the newly accessible media content ... **prior to accessing of the newly accessible media content by the at least one communication device,**" as recited by the Applicant in independent claim 1 (emphasis added).

Accordingly, independent claim 1 is not anticipated by Kerman and is allowable. Independent claims 12 and 15 are similar in many respects to the system disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 12 and 15 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 4-8, 10, 13-14 and 16-18

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 12 and 15 under 35 U.S.C. § 102(b) as being anticipated by Kerman has been overcome and requests that the rejection be withdrawn. Additionally, claims 4-8, 10, 13-14 and 16-18 depend from independent claims 1, 12 and 15, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 4-8, 10, 13-14 and 16-18.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., " citing *Al-Site Corp. v. VSI Int'l*

Inc., 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

II. The Proposed Combination of Kerman and Hunter Does Not Render Claims 2, 3, 9, 11 and 19-22 Unpatentable

The Applicant now turns to the rejection of claims 2, 3, 9, 11 and 19-22 as being unpatentable over Kerman in view of Hunter.

A. Rejection of Independent Claim 19

Independent claim 19 is similar in many respects to the system disclosed in independent claim 1. Therefore, the Applicant submits that independent claim 19 is also allowable over the reference cited in the Office Action at least for the reasons stated above with regard to claim 1. Additionally, since the additional cited reference (Hunter) does not overcome the deficiencies of Kerman, claim 19 is also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to

argue additional reasons beyond those set forth above to support the allowability of claim 19.

B. Rejection of Dependent Claims 2, 3, 9, 11 and 20-22

Based on at least the foregoing, the Applicant believes the rejection of independent claim 1 under 35 U.S.C. § 102(b) as being anticipated by Kerman has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Hunter) does not overcome the deficiencies of Kerman, Claims 2, 3, 9 and 11 depend from independent claim 1, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1.

Based on at least the foregoing, the Applicant believes the rejection of independent claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Kerman in view of Hunter has been overcome and requests that the rejection be withdrawn. Additionally, claims 20-22 depend from independent claim 19, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2, 3, 9, 11 and 20-22.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-22 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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